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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,659	06/10/1999	DAVID A. FENTON	99-40113-US	8381

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EXAMINER

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/329,659

Applicant(s)

FENTON ET AL.

Examiner

Robert W. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/7/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 1/7/02 in paper number 12, has been entered. Now claims 1-40 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-15, 17-24, 26-32 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent No. 4,831,526 to Luchs et al., in view of “Instant Auto Insurance Quotes Now available at Quotesmith.com” to Bland for the same reasons given in the previous Office Action (paper number 10).

Claims 1-4, 6-15, 17-24, 26-32 and 35-40 have not been amended and are rejected for the same reasons given in the prior Office Action. Further reasons are provided in the “Response to Arguments” section of the present Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 16, 25, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,831,526 to Luchs et al. in view of U.S. Patent No. 6,064,987 to Walker et al., for substantially the same reasons given in the previous Office Action (paper number 10).

Claims 5, 16, 25, and 34 have not been amended and are rejected for the same reasons given in the prior Office Action. Further reasons are provided in the "Response to Arguments" section of the present Office Action.

Response to Arguments

6. Applicant's arguments filed 1/7/02 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 1/7/02.

In the remarks, applicants argue in substance that, (1) Bland does not address the activation of the coverage and "issuing" of a policy to a user during a single user session and (2) the copy of Auto FAQ on Quotesmith.com web site citing the question "When can my policy start?" indicates that a policy of insurance cannot be issued or activated to a purchasing user on the web site until, at the earliest, the next day or some cases as many as five days.

In response to the Applicants arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly

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suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to Applicant's argument the teachings of Bland fails to address the activation of the coverage and "issuing" of a policy to a user during a single user session, the Examiner respectfully submits that the Bland reference, and not Luchs et al., *per se*, that was relied upon for the specific teaching of receiving instant automobile insurance quotes from over 300 insurance companies on the Internet and once the customer was satisfied with the quote the policy could be purchased immediately on-line (see: Bland: paragraph 1 and 3). Luchs et al. was relied for primarily teaching of a computerized insurance premium quote request and policy issuance system that includes a decision step (120) in which a client is offered a policy and must decide to accept or decline (see: Luchs et al.: column 17, lines 1-15). Thus, the proper combination of the applied references would incorporate Bland teaching of receiving instant automobile insurance quotes from over 300 insurance companies on the Internet and once the customer was satisfied with the quote the policy could be purchased immediately on-line within Luchs et al. the computerized insurance premium quote request and policy issuance system.

Furthermore, the Examiner notes that the Applicant's analysis fails to consider the teachings of Bland together with that of Luchs. Thus, as noted above, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the Applicants argument regarding the copy of Auto FAQ on

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Quotesmith.com web site citing the question “When can my policy start?” indicates that a policy of insurance cannot be issued or activated to a purchasing user on the web site until, at the earliest, the next day or some cases as many as five days. The Examiner respectfully submits that reference of Bland teaches that a customer once satisfied with the insurance quote of a policy, may purchased it immediately on-line (see: Bland: paragraph 1 and 3). This suggests that a once policy is **immediately** purchased on-line by a customer, the policy is considered issued or activated. With respect to the recitation in the Auto FAQ by Quotesmith.com that in some cases, policies begin in five days from application date, the Examiner respectfully submits that Quotesmith.com receives quotes from 300 different insurance companies and it appears that ,in some cases a customer may decide to make arrangements through the insurance companies’ web site to make payment for a policy that is to be activated days later, for example, by setting up the initial payment date and the activation date of a policy to begin days later from the customer’s initial access of the web site. However, in this case the transaction of setting the start date of the policy may be completed during the customer’s initial access session.

In light of the above, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Thus, the fact situations provided by the Examiner, no matter how infrequent or occasional they may be, are indeed embodiments that Applicant is expected to have considered. As such, since Applicant fails to expressly recite limitations that provide a patentable distinction over such fact situations, it is respectfully submitted that prior art either reads on or makes obvious Applicant's claimed limitations.

Additionally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "immediately starting the policy") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is 703-605-4441.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

RWM
rwm
August 16, 2002


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600